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10/057,337	01/23/2002	Richard S. Dick	9595.9	3331

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/057,337

Applicant(s)

DICK, RICHARD S.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/7/02, 1/9/06</u> | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-24 have been examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 3 and 8 recite the phrase "wherein verifying the request includes..." However, there is no previous recitation of a step of "verifying the request." Therefore, there is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-17, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., U.S. Patent No. 5,867,821 in view of McCallum, U.S. Patent No. 5,784,635.
6. As per claim 1, Ballantyne teaches a method of searching for medical information executed by one or more computers comprising: a) receiving a request for medical information from a requestor including identification of a subject (see column 7, lines 19-22); b) transmitting

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a query to a medical information repository for information pursuant to the request (see column 7, lines 19-22 and figure 1); c) transmitting a response to the request including information based on the response to the query (see column 7, lines 32-39).

7. Ballantyne does not explicitly teach that the response is de-identified prior to transmission to remove any identifying information therein. McCallum teaches a system for acquiring medical data in which responses are de-identified prior to transmission to remove any identifying information therein (see column 5, lines 58-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ballantyne. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing access to patient information to a wide range of users without compromising confidentiality (see column 3, lines 21-31 of McCallum).

8. As per claim 2, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches the request further includes a signed information release (see column 15, lines 2-8).

9. As per claim 3, Ballantyne in view of McCallum teach the method of claim 2 as described above. Ballantyne further teaches verifying the request includes verifying the signed information release (see column 15, lines 2-8).

10. As per claim 4, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches utilizing the medical information as a surrogate for a physician-based medical record (see column 10, lines 10-21).

11. As per claim 8, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches verifying the source of the request (see column 8, lines 20-28).

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12. As per claim 9, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches the response includes medication information, further comprising determining a probable location of medical information based on the medication information (see column 7, lines 39-45).

13. As per claim 10, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches the response includes clinical information, further comprising determining a probable location of medical information based on the Clinical information (see column 7, lines 39-45).

14. As per claim 11, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches verifying the request (see column 8, lines 20-28).

15. As per claim 12, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches receiving a response to the query (see column 7, lines 19-31).

16. As per claim 13, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne further teaches the response to transmitted directly to the requestor (see column 10, lines 10-15).

17. Claims 14-17 and 21-22 contain substantially similar limitations to those already addressed in claims 1, 3, and 8-11 and, as such, are rejected for similar reasons as given above.

18. As per claim 23, Ballantyne teaches a method for gathering and formatting medical information regarding an individual, and making that information available to a requestor, the method comprising the steps of: a) searching at least one medical information repository for medical information regarding a group of preselected individuals (see column 7, lines 19-22); b) compiling and formatting at the site of the medical information repository the aggregate results

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of the search in a generic format ascertainable by requestor (see column 7, lines 27-31); and d) providing the compiled aggregate results of at least one of the preselected individuals to a requestor upon verification that the request is authorized (see column 8, lines 41-46).

19. Ballantyne does not explicitly teach step c) de-identifying the results of the search.

McCallum teaches a system for acquiring medical data in which responses are de-identified prior to transmission to remove any identifying information therein (see column 5, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ballantyne. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing access to patient information to a wide range of users without compromising confidentiality (see column 3, lines 21-31 of McCallum).

20. As per claim 24, Ballantyne teaches a method of providing relevant medical data from a medical information repository to a requestor in a format ascertainable by a requestor, the method comprising the steps of: a) receiving a query regarding the medical history of an individual (see column 4, lines 30-36 and column 7, lines 19-22); b) searching and compiling medical information from third party sources (see column 6, lines 47-53 and column 7, lines 19-22); and d) providing the compiled medical information to satisfy the query (see column 7, lines 27-31).

21. Ballantyne does not explicitly teach step c) de-identifying the medical information.

McCallum teaches a system for acquiring medical data in which responses are de-identified prior to transmission to remove any identifying information therein (see column 5, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ballantyne. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing access to patient

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information to a wide range of users without compromising confidentiality (see column 3, lines 21-31 of McCallum).

22. Claims 5-7 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., U.S. Patent No. 5,867,821 in view of McCallum, U.S. Patent No. 5,784,635 and further in view of Rozen et al., U.S. Patent No. 6,073,106.

23. As per claim 5, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne does not explicitly teach that the request is received by an internet website from an internet browser program executing on a computer communicating with the internet website. Rozen teaches receiving a request for medical information by an internet website from an internet browser program executing on a computer communicating with the internet website (see column 7, lines 40-48). It would have been obvious to one of ordinary skill in the art of patient record management to provide internet access to the medical library of Ballantyne as taught by Rozen. One of ordinary skill in the art would have been motivated to add this feature to the invention of Ballantyne for the purpose of providing wider availability of access to patient information to the physicians using the system of Ballantyne (see column 1, lines 57-62 of Ballantyne).

24. As per claim 6, Ballantyne in view of McCallum teach the method of claim 1 as described above. Ballantyne does not explicitly teach transmitting the query to the medical information repository by an internet website communicating with the medical information repository. Rozen teaches transmitting a query to a medical information repository by an internet website communicating with the medical information repository (see column 8, lines 1-8). It would have been obvious to one of ordinary skill in the art of patient record management to provide internet access to the medical library of Ballantyne as taught by Rozen. One of ordinary skill in the art

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would have been motivated to add this feature to the invention of Ballantyne for the purpose of providing wider availability of access to patient information to the physicians using the system of Ballantyne (see column 1, lines 57-62 of Ballantyne).

25. As per claim 7, Ballantyne in view of McCallum and Rozen teach the method of claim 5 as described above. Ballantyne further teaches that the communicating computer operates according to input from a device capable of detecting the presence of an authorized user (see column 8, lines 20-28).

26. Claims 18-20 contain substantially similar limitations to those already addressed in claims 5-7 and, as such, are rejected for similar reasons as given above.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

6/12/06



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TECHNOLOGY CENTER 3600**